

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP § 803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has characterized the inventions of Groups I, II, and IV as “structurally unrelated.” However, Applicants note that the MPEP describes unrelated inventions as, for example, “an article of apparel such as a shoe, and a locomotive bearing”, or “a process of painting a house and a process of boring a well.” MPEP § 806.04(A). Thus, unrelated inventions, as defined by the MPEP, are inventions which are directed to *completely* different technical fields, and have no reasonable relationship with each other. Applicants make no statement with regard to the patentable distinctness of the inventions of Groups I, II, and IV, but respectfully submit that the Office has not shown how the inventions of these groups meet the standard of “unrelatedness” of MPEP § 806.04(A). In addition, Applicants note that the inventions of Groups I and II are classified in the same class and subclass. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

The Office has characterized the inventions of Groups II and III as related as product and process of use. Citing MPEP § 806.05(f), the Office suggests that the “bacteria of Group II can be used in a materially different process such as one in which the bacteria are used to synthesize and characterize a nucleic acid.” However, there is no evidence of record to show that the alleged use of the “bacteria of Group II” to “synthesize and characterize a nucleic acid” is materially different from the claimed process, nor has the Office provided any

arguments or examples to support this conclusion. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

The Office has characterized the inventions of Groups I and III as “unrelated”. However, as discussed above, MPEP § 803.04(A) defines “unrelated” inventions as being directed to *completely* different technical fields having no reasonable relationship with each other. Applicants make no statement regarding the patentable distinctness of the inventions of Groups I and III, but respectfully submit that the Office has failed to show how these inventions meet the standard of “unrelatedness” of MPEP § 806.04(A). Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

The Office has characterized the inventions of Groups IV and III as related as process of making and product made. The Office suggests that the product “can be made synthetically (chemically).” However, the Office has failed to show that the alleged synthetic or chemical process is materially different from the claimed process. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

The Office has characterized the inventions of Groups I and V as related as product and process of use. The Office concludes that the product of Group I can be “used to synthesize the encoded proteins.” However, the Office has merely stated a conclusion, and has not provided reasons and/or examples to support this conclusion. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

The Office states that the inventions of Groups II and IV are “unrelated to the methods of Group V.” However, Applicants respectfully submit that the Office has merely stated a conclusion, and has not shown how the inventions of Groups II, IV and V are

"unrelated" under the standard of MPEP § 806.04(A), discussed above. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

The Office states that the methods of Groups III and V are "independent". However, MPEP § 802.01 defines the term "independent" to mean that there is "no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". However, Applicants note that the inventions of Groups III and V are classified in the same class, and therefore fail to see how these inventions have "no disclosed relationship" or are "unconnected" under the standard of MPEP § 802.01. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER, & NEUSTADT, P.C.



22850

Tel.: (703) 413-3000
Fax: (703) 413-2220
NFO:TAB/bwt
I:\ATTY\TAB\211712US-AM.DOCs

A handwritten signature in dark ink, appearing to read "N. F. Oblon".

Norman F. Oblon
Attorney of Record
Registration No.: 24,618

Thomas A. Blinka, Ph.D.
Registration No.: 44,541